

REMARKS

Claims 1-21, 27, and 28 are pending. Claims 1-5, 8-13, 17, 21, 27, and 28 stand rejected. Applications appreciate the Examiner's allowance of claims 18-20, and the Examiner's indication that claims 6, 7, and 14-16 are allowable and would be allowed if rewritten to include all of the limitations of the base claim and any intervening claims.

Claim Amendments

Applicants amend claims 1 and 21 to include some of the subject matter from claim 6, and in particular to recite the steps of extending a guide wire from the distal end of the catheter beyond the point of juxtaposition, and guiding a fastening device along the guide wire to the point. No new matter is added. Claim 6 is amended to replace "a guide wire" with "the guide wire." Claim 14 is amended into independent format to include all of the limitations of claim 1.

No new matter has been added.

Allowable Subject Matter

The Examiner has indicated that claims 6, 7, and 14-16 represent allowable subject matter, and that these claims would be allowed if rewritten in independent format to include all of the limitations of the base claim and any intervening claims. The Examiner admits that the prior art fails to disclose the step of guiding a stapling device along a guide wire extending from the catheter. Accordingly, independent claims 1 and 21 are amended to include such a limitation, and therefore claims 1 and 21, as well as claims 2-13, and 17 which depend therefrom, represent allowable subject matter. The Examiner also admits that the prior art fails to disclose a catheter having an obstruction balloon, as recited in claim 14. Applicants thus amend claim 14 to include all of the limitations of independent claim 1, and therefore claim 14, as well as claims 15-16 which depend therefrom, represents allowable subject matter.

In sum, claims 1-21 are now in condition for allowance and allowance thereof is respectfully requested. Remaining claims 27-28 are discussed below.

Claim Rejections

Claims 27 and 28 stand rejected pursuant to 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,629,534 of St. Goar et al. (St. Goar). The Examiner relies on St. Goar to disclose a method for repairing a mitral valve in the heart of a patient that includes the steps of inserting a catheter through the atrium to the mitral valve, gripping opposed leaflets of the mitral valve with the catheter, and stapling the opposed leaflets. The Examiner admits that St. Goar does not teach the step of stapling the immobilized leaflets with a stapling device inserted from a direction *opposite* to the direction of insertion of the catheter assembly, as required by independent claim 27. The Examiner merely argues that such a step would have been inherent since St. Goar discloses stapling device separate from the catheter. Applicants respectfully disagree.

St. Goar discloses several fastening devices for use in stapling or otherwise attaching valve leaflets to one another. These devices are discussed at Col. 31, line 64 to Col. 38, line 58, and each device is either part of the catheter assembly, or is used in conjunction with the catheter assembly by passing the device through or along the catheter assembly. St. Goar does not teach or even suggest applying a stapling device inserted from a direction *opposite* to the direction of the catheter assembly.

The Examiner's argument that St. Goar *inherently* discloses the claimed method of applying a stapler in an opposite direction to the catheter, as required by claims 27-28, is unsupported and is improper.

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled . . . [such] that *the missing . . . matter is necessarily present in the . . . reference*, and that it would be so recognized by persons of ordinary skill. . . . "*Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. . . .*"

Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (citations omitted) (emphasis added) (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

The fact that St. Goar discloses a stapling apparatus that is separate from the catheter does not necessarily mean that the stapler can be applied in an opposite direction to the catheter. In fact, St. Goar specifically discloses use of the stapler on the same side of the catheter. St. Goar therefore does not necessarily or inherently disclose the claimed method, and the claimed invention certainly would not be recognized in the teachings of St. Goar by persons of ordinary skill in the art.

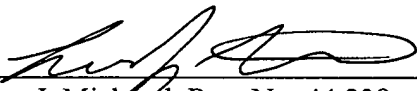
Accordingly, claim 27, as well as claim 29 which depends therefrom, therefore represents allowable subject matter.

Conclusion

In view of the amendments and remarks above, Applicants submit that claims 1-22 and 27-28 are in condition for allowance. In the event that the above amendments and remarks are not deemed to place this case in condition for allowance, an opportunity to interview with the Examiner is requested. Applicants encourage the Examiner to telephone the undersigned upon receipt of this response to discuss any issues that may remain.

Respectfully submitted,

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